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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,884	09/28/2001	Anthony J. Baerlocher	0112300-482	5171

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EXAMINER	
MARKS, CHRISTINA M	
ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,884	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-28 and 38-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-28 and 38-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11172003 02092004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

q.m.

DETAILED ACTION

Double Patenting

The rejection of claims 1-44 under obvious-type double patenting has been withdrawn due to the Terminal Disclaimer filed 17 November 2003.

Election/Restrictions

Claims 29-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 19 March 2004.

Claim Rejections - 35 USC § 112

The rejection of claims 1-44 has been withdrawn due to the amendment filed 19 March 2004 either withdrawing or amending the claims to overcome the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11-28 and 38-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell (EP 0 449 433).

Farrell discloses a gaming machine that has a processor and presents the player with a first set of potential offers (page 4, lines 19-24), a second set of potential offers (page 4, lines 25-30), a display device (FIG 1) and a means for enabling the player to accept or reject the first offer (page 4, lines 19-30).

Farrell does not explicitly disclose that the second set of offers is based on the total value of all previous offers; however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham,* 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claims dictated the Farrell device configured as bonus presentation device is capable of being used in a different manner (present different amounts) that would not result in a structural difference, only a difference of a software program executed by the respective processors. Hence the recitation that the device be employed in a specific manner regarding the actions of the structure does not differentiate the claimed apparatus from the Farrell apparatus, which satisfies the claimed structural limitation. Additionally, the Applicant is invited to review MPEP §2114 R-1 which states: MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a

"recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).* Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)* (emphasis in original).

Additionally, mathematical computations involving the amount of prize to be offered would be obvious to alter to a skilled artisan. Farrell does not go into detail about the mathematical value of the prizes offered in the system; it is just merely disclosed that when the player does not collect the offered prize, they are presented with a new offer. Altering the function by which that value is calculated would be obvious to the skilled artisan who would have a strong mathematical and statistical background and would be motivated to alter the values as a means to find the maximum combination of attracting players and maintaining profit through the payout schedule.

Regarding claims 2-4, 8-9, 11-15, 20-22, 26-28, 39-40, 44 and 52-53, the second offer is offered to the player if they reject the first offer (page 4, lines 19-30). As discussed above, it would be obvious to alter the value and the mathematical functions to determine it. Farrell also discloses that it is possible on the second offer that the player can lose everything (page 4, lines 28-30). Hence, the first offers serves as a terminator to the second set because it would be lost when it is not chosen and can result in the player winning nothing. A combination of these types of offers or alterations on the offers value would be obvious for the reasons identified above.

Regarding claims 5-6 and 19, it would have been obvious to a skilled artisan to allow the player to continue with a number of offers once they accept and/or reject another offer. The

system of Farrell is set up to provide the player with an offer and allow them to choose or risk it. It would serve to be obvious to a skilled artisan that this process could be looped as many times as desired by the design of the programmer. This merely is the intended use of the structure and would be obvious to a skilled artisan as a means to further entice and excite the player by temptations of larger and more lucrative payouts.

Regarding claims 7 and 17, the means to accept or reject the offer is an offer acceptor (collect button) that communicates the intention of the player to the machine (page 6, lines 23-24).

Regarding claim 16, Farrell discloses that the rejection of the first offer can result in a potential terminator to be awarded (thus displayed) to the player.

Regarding claims 18, 41-43 and 46-47, it is notoriously well known in the art to offer a consolation prize to players in a bonus environment to assure a prize is won. It is known that upon a terminator symbol, players are often given a consolidation award based upon how far they were in the bonus round so they will still receive a bonus even if they "lost" the bonus round. The means in which the consolation prize is awarded, calculated, supplemented, or shown would be easily conceived, altered and designed by one of ordinary skill in the art and thus would be obvious design choices to a skilled artisan in relation to incorporating a terminator and compensating a player for the bonus. Motivation for doing so in the eyes of the designer is to reward players for the bonus round as it would be extremely discouraging if they were to leave with nothing after the excitement caused by making it into the bonus.

Regarding claim 24, the values are offered based upon the random generation used in the slot machine (page 4, lines 15-20).

Regarding claim 25, the device is a number appearing on the ladder indicator and is presented to the player (page 4, lines 15-20).

Regarding claim 45, the system of Farrell lends itself a method of operation that comprises displaying a plurality of offers and generating a first offer for the player (page 4, lines 19-25), changing the value of a remaining offer (page 4, lines 23-25), enabling the player to reject or accept the offer (page 4, lines 19-25) and if the player rejects the offer, generating a newly changed offer for the player (page 4, lines 19-30). Farrell does not disclose in the method that the changed value is based on the total value of prior offers; however, mathematical computations involving the amount of prize to be offered would be obvious to alter to a skilled artisan. Farrell does not go into detail about the mathematical value of the prizes offered in the system; it is just merely disclosed that when the player does not collect the offered prize, they are presented with a new offer. Altering the function by which that value is calculated would be obvious to the skilled artisan who would have a strong mathematical and statistical background and would be motivated to alter the values as a means to find the maximum combination of attracting players and maintaining profit through the payout schedule.

Regarding claims 48-49, the method includes awarding the player the first offer if they accept it (page 4, lines 23-24) or the second if they accept it.

Regarding claims 50-51, Farrell discloses a path that is displayed that is indicative of the offers that are to be presented and each offer is generated based on the position along the path (FIG 1).

Response to Arguments

Applicant's arguments with respect to claims 1-9, 11-28 and 38-53 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0 219 305: Gaming machine with a prize display that includes moving along a path to obtain different awards.

GB 2 183 882: Gaming machine that allows player to bank award amounts to accumulate a total.

GB 2 090 690: Gaming machine with special features that allows the player to move along a path to accumulate nudges.

GB 2 170 636: Gaming machine with the ability for the player to use a money pot to accumulate winnings.

US Publication 2003/0036430: Gaming method with a ladder format that allows the player to progress through awards.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
June 24, 2004

JOHN M. HOTALING, II
PRIMARY EXAMINER